

REMARKS

This paper responds to the Office Action mailed December 17, 2003 in the present application, and also discusses an Office Action mailed November 6, 2003 in this application. Claims 1-103 were previously pending in this application. Claims 51-103 presently are withdrawn from consideration. No claims have been amended. New claim 104 has been added. As a result claims 1-50 and 104 are pending for examination with claim 1 being the only independent claim. Applicants respectfully request reconsideration.

Summary of Telephone Conference with Examiner

On November 25, 2003, the Applicants' attorney had a telephone conference with the Examiner in the present case regarding the Office Action mailed November 6, 2003. During the telephone conference, the Applicants' attorney discussed with the Examiner the statutory period for reply to the Action, which was set at one month. The Examiner indicated that the one-month statutory period for reply was an error and that he would likely issue a new Office Action to set the appropriate three-month statutory reply date. Ultimately the Examiner, indeed, issued another Office Action, mailed December 17, 2003, to which the present paper responds.

During the November 25, 2003 interview, the Applicants' attorney also asked the Examiner about his comment on page 2 of the November 6, 2003 Office Action that stated "Applicant is required to submit an amendment which clarifies the disclosure so that the Examiner may make a proper comparison of the invention with the prior art." The Examiner commented that he did not immediately recall why he put this comment in the Office Action but said that he would look into it and appropriately comment in a follow-up Office Action. In the December 17, 2003 Office Action, the Examiner in fact withdrew this request.

The Applicants' attorney also discussed with the Examiner the Examiner's comments in item 2 on page 2 of the November 6, 2003 Office Action, regarding information disclosure statements. In particular, the Office Action alleged that four information disclosure statements previously filed failed to comply with the relevant provisions of the MPEP because the references were not submitted with the information disclosure statements. The Applicants' attorney indicated to the Examiner that this case claims priority to a number of parent cases in which all the references cited in the indicated IDS's were previously cited. The Examiner said

he would further look into this situation. In the December 17, 2003 Office Action, the Examiner apparently found the Information Disclosure Statement in compliance with the relevant MPEP provisions.

Finally, the Applicants' attorney discussed with the Examiner the traversal of a Restriction Requirement (mailed June 17, 2003) and the Examiner's making final the Restriction Requirement in item 1 on page 2 of the November 6, 2003 Office Action. In particular, the Applicants' attorney pointed out to the Examiner that the only two independent claims of the case both recite "a user input." Again, the Examiner said he would look into this situation and make appropriate comment in a follow-up Office Action to replace the November 6, 2003 Office Action. In the December 17, 2003 Office Action, the Examiner maintained the restriction requirement. Applicants' have since filed on January 12, 2004 a Petition to the Commissioner from Requirement for Restriction.

Rejections Under 35 U.S.C. §102

The December 17, 2003 Office Action rejected claims 1-9, 23, 28-31, 33-34, 40, 43-44 and 47-50 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,018,237 to Havel (hereinafter Havel). The Applicants respectfully traverse these rejections.

Firstly, Havel is not a prior art reference under 35 U.S.C. §102(b). 35 U.S.C. §102(b) states in the relevant portions that "A person shall be entitled to a patent unless ... (b) the invention was patented ... more than one year prior to the date of the application for patent in the United States." Havel was patented on January 25, 2000, and the present application claims priority back to December 17, 1998. Accordingly, any rejection under 35 U.S.C. §102(b) based on Havel is improper and should be withdrawn. Applicants proceed under the assumption that the Office Action intended to use Havel as a prior art reference under 35 U.S.C. §102(e)

Havel discloses a digital multimeter having an alphanumeric color display. Havel discloses that the textual/numeric measurement information may be displayed in a given color based on a mode of measurement (e.g., AC, DC, resistance, capacitance).

I. Regarding independent claim 1

The Office Action alleges that "Havel discloses a plurality of LEDs configured to produce light that includes at least two different spectra; a material configured to receive the

light emitted from the plurality of LEDs, and to display a color that is a combination of the at least two different spectra; a processor (168) configured to generate at least one control signal to control power delivered to one or more of the plurality of LEDs, the processor (168) further configured to change the at least one control signal over time so as to produce from the device at least one dynamic lighting effect; and a user interface (117 and 1169) adapted to receive a user input to control operation of the processor (168).” The Applicants disagree with the foregoing characterization and respond as follows.

As used in the claims, the term “dynamic lighting effect” refers to a decorative presentation of a sequence of colored light (see for example page 2, line 20 et seq. in the background of the specification). As such, Havel does not disclose or suggest a device comprising “a processor [] configured to change [an] at least one control signal over time so as to produce from the device at least one dynamic lighting effect,” as recited in claim 1. Instead, Havel discloses a digital multimeter that includes a display for displaying alphanumeric characters in a predetermined color based on a mode of the meter. At no point does Havel disclose or suggest that the color of the displayed alphanumeric characters is controlled to produce a dynamic lighting effect (i.e., a decorative presentation of a sequence of colored light) as recited in claim 1. Accordingly, claim 1 patentably distinguishes over Havel.

Claims 2-9, 23, 28-31, 33-34, 40, 43-44 and 47-50 depend from claim 1 and are patentable for at least the same reasons. Accordingly, withdrawal of these rejections is respectfully requested.

II. Discussion of Selected Dependent Claims

As stated above, each of dependent claims 2-9, 23, 28-31, 33-34, 40, 43-44 and 47-50 was rejected as allegedly being anticipated by Havel. Although each of dependent claims 2-9, 23, 28-31, 33-34, 40, 43-44 and 47-50 are patentable by virtue of their dependency from claim 1, select ones of said claims are discussed below to particularly point out examples of the Examiner’s mischaracterization of Havel, and the patentability of these claims over Havel based on various features recited in the indicated claims.

Regarding dependent claim 7

Claim 7 recites a device configured to produce at least one dynamic lighting effect “wherein the dynamic lighting effect comprises at least one color-changing effect including at least one of a color wash, a strobe, a fade, or a Holiday lighting effect.” Havel does not disclose or suggest a device configured to produce a dynamic lighting effect, much less color-changing effects including at least one of a color wash, a strobe, a fade, or a Holiday lighting effect. To the contrary, Havel is directed to a digital multimeter having a display for displaying alphanumeric information such as numbers and characters in a predetermined color. Accordingly, dependent claim 7 is clearly patentable over Havel and the rejection of said claim should be withdrawn.

Regarding dependent claim 30

Claim 30 recites a device “wherein the processor is configured to receive information from a network and process the information so as to generate the at least one control signal.” Havel does not disclose or suggest a device configured to receive information from a network. Accordingly, dependent claim 30 is clearly patentable over Havel and the rejection of said claim should be withdrawn.

Regarding dependent claim 34

Claim 34 recites a device “wherein [a] material [configured to receive light] includes a pattern of defects configured to redirect the light passing through or along the material.” Havel does not disclose or suggest a material including a pattern of defects configured to redirect the light passing through or along the material. Accordingly, dependent claim 34 is clearly patentable over Havel and the rejection of said claim should be withdrawn.

Regarding dependent claim 44

Claim 44 recites a device “comprising a power connection adapted to engage mechanically and electrical with a convention a light socket.” As noted above, Havel discloses a digital multimeter having an alphanumeric display. Havel does not disclose or suggest a device comprising a power connection adapted to engage mechanically and electrically with a

conventional light socket. Accordingly, dependent claim 44 is clearly patentable over Havel and any rejection of said claim should be withdrawn.

Rejections Under 35 U.S.C. §103

The Office Action rejected claims 10-22, 24-27, 32, 35-42 and 45-46 under 35 U.S.C. §103(a) as allegedly being obvious over Havel. The Office Action asserts that Havel discloses the claimed invention “except for a light bulb, or a night light or a rope light or a household product or a pen or at least part of a consumer electronic device or a glow stick or an ornamental or decorative lighting device, et al. However, the Office Action alleges that it would have been obvious to one having ordinary skill in the art to have any of the claimed articles, since it has been held to be within the general skill of one of ordinary skill in the art to select a known material on the basis of its suitability for *intended use* as a matter of obvious design choice” (emphasis added).

I. “Intended Use”

As can be best understood from the Office Action, the stated basis for rejecting each of claims 10-22, 24-27, 32, 35-42 and 45-46 appears to involve a concept referred to by the Examiner as “intended use.”

Notably, the Examiner concedes that Havel fails to disclose or suggest at least one limitation positively recited in the body of each rejected claim; however, the Examiner alleges that somehow Havel nonetheless provides a proper bases for rejecting the claims, notwithstanding the missing limitations, because the missing limitations are “merely intended uses” (see Office Action, page 6).

In connection with the so-called “intended use” concept apparently relied upon by the Examiner, the Applicants’ attorney is not aware of any rule or doctrine set forth in the patent statutes, the patent rules, or the MPEP regarding “intended use” that in any way could possibly be related to the rejection of the present claims.

The phrase “intended use” does appear in MPEP §1503.01 and in 37 C.F.R. §1.154(b)(1), with respect to the specification of a design patent. In particular, both MPEP §1503.01 and in 37 C.F.R. §1.154(b)(1) state that the specification of a design patent “should include the following

sections in order: (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and *intended use* of the article in which the design is embodied....” (italics added).

The phrase “intended use” also appears in MPEP §806.05(e) in connection with restriction requirements, in a section entitled “Process and Apparatus for Its Practice-Distinctness.” This section discusses when a restriction requirement may be supported by showing that a process and apparatus for its practice are distinct inventions. In analyzing when a claim may not serve as a linking claim in such a restriction, MPEP §806.05(e) states that “it should be noted that a claim such as, ‘An apparatus for the practice of the process of claim 1, comprising’ and then the claim continues with purely apparatus limitations, is not a linking claim. This is merely a preamble similar to a statement of *intended use* and should be treated as any preamble” (italics added).

The phrase “intended use” also appears in MPEP §2106 II(C) regarding patentable subject matter in computer-related inventions. More specifically, this section of the MPEP discusses the interpretation of claims for examination of computer-related inventions. MPEP §2106 II(C) states that:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of *intended use* or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses. This list of examples is not intended to be exhaustive (italics added).

Again, Applicants respectfully submit that the foregoing references to “intended use” in the above-indicated authorities do not appear to be at all relevant to the claims at issue in the present application. If the Examiner is relying on some other authority in support of his rejections of the claims based on so-called “intended use,” the Examiner is respectfully requested to cite this authority. Otherwise, the rejections of the claims as set forth in the Office Action should be withdrawn, as discussed further below.

requested to cite this authority. Otherwise, the rejections of the claims as set forth in the Office Action should be withdrawn, as discussed further below.

II. Obviousness Criteria

As set forth in MPEP § 2143, three criteria must be met in order to establish a *prima facie* case of obviousness. First, there must be some specific suggestion or motivation, either in the cited reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s). Second, there must be a reasonable expectation of success. The specific teaching or suggestion to modify the reference(s), as well as the reasonable expectation of success, must both be found in the prior art and not based on Applicants' disclosure. Third, the reference(s) must teach or suggest all of the claimed features.

In the present application, the Examiner has significantly failed to establish a *prima facie* case of obviousness.

First, as discussed above, the cited Havel reference fails to disclose or suggest one or more features recited in each of Applicants' rejected claims; specifically, at least one element of each rejected independent claim is *entirely missing* from and *not suggested* in Havel. For at least this reason, the obviousness rejections are improper, as the third obviousness criterion stated above is not met.

Second, the Examiner has completely failed to point to any specific motivation or suggestion in the prior art to modify the cited Havel reference to provide the missing claim elements. To support an obviousness rejection, the Examiner must specifically identify a motivation to change the prior art to fall within the scope of the claims. If the Examiner fails to clearly and particularly identify in the prior art any suggestion, teaching, or motivation to modify a reference, the rejection cannot be maintained. With respect to such suggestion or motivation, in the present case the Examiner has clearly failed to meet this obviousness criterion.

Finally, the Examiner fails to point to any evidence in the prior art that there is any reasonable expectation of success in modifying the cited Havel reference to provide the missing elements required by Applicants' claims. In fact, there is absolutely no evidence in Havel or

any other reference of record that the teachings of Havel are at all suitable for, or applicable to, Applicants' claimed apparatus.

In sum, the Examiner has failed to meet his burden with respect to each of the three criteria required to establish a *prima facie* case of obviousness. Failure to meet any one of these criteria – a teaching or suggestion of all claim elements, a specific suggestion or motivation to modify the prior art, and a reasonable expectation of success – is sufficient to render such a rejection improper. In the present case, *the Examiner's basis for rejection is deficient with respect to all three criteria*. Accordingly, the rejections must be reversed.

Accordingly, withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, the Applicants hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50/2762.

Respectfully submitted,
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Docket No.C01104/70016
Date: May 17, 2004